

### **Remarks and Arguments**

Applicant has carefully considered the Office Action dated April 14, 2005 and the references cited therein. Applicant respectfully requests reexamination and reconsideration of the application.

Applicant acknowledges the examiner's objection to the specification and respectfully requests that such objection be held in abeyance until applicant can prepare a properly formatted amendment which corrects all such occurrences of duplicative reference characters.

The Examiner has indicated the claims 10-13, 16-18, 20-22, 24-25, 27 and 29 of this application conflict with claims 1-8, 10-11, 13-14, and 19 of Application No. 09/954,763. Applicant respectfully disagrees with the Examiner's position. Specifically, claim 1 of application serial number 09/954,763 currently recites a catheter system comprising "a stent mounting location located near said distal ends of said inner and outer tubular members" (09/954,763, claim 1, lines 12-13). Claims 2-8, 10-11, 13-14 and 19 of the '763 application depend either directly or indirectly from claim 1 and likewise inherit this limitation from claim 1. None of claims 10-13, 16-18, 20-22, 24-25, 27 and 29 of the subject application recite an identical or analogous limitation. Accordingly, applicant respectfully asserts that no conflict exists between these claim sets and that cancellation of claims in either application is not required.

Claim 10-21, 24-29 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-5, 10-13, and 15 of U.S. Patent No. 6,623,491. Applicant respectfully requests that the examiner hold such rejection in abeyance until such time as allowable subject matter is indicated in the subject application.

Claims 10-18, 20-25 and 27-29 stand rejected under 35 USC 102(b) as being anticipated by US Patent 5,279,546, Mische et al., hereafter Mische. In setting forth the rejection, the Examiner has cited specific sections of Mische which are alleged to disclose the limitation of these claims. Applicant respectfully traverses the rejection as improper. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicant believes the examiner has misinterpreted Mische. Generally, applicant believes that Mische does not teach an inner and outer tubular member, as suggested, but rather merely teaches a single tubular member containing a plurality of lumens completely defined within the core of the tubular member itself.

Claim 10 specifically recites a treatment system comprising “a fluid passage defined between the wall of the inner member and the wall of the outer member” (claim 10, lines 10-11). Using the examiner's own analogy of the claimed inner member being analogous to inner catheter 72 of Mische and the claimed outer member being analogous to the outer catheter 70 of Mische, the examiner has not shown where Mische discloses a fluid passage defined *between* the wall of inner catheter 72 and the wall of outer catheter 70. The aspiration lumens 126, 128, 130, and 132 of Mische allegedly defined between the wall of the inner catheter 72 and the wall outer catheter 70 are integrally formed and completely defined *within* the wall of outer catheter 70 itself, not *between* the wall of outer catheter 70 and the wall of inner catheter 72. None of aspiration lumens 126, 128, 130, and 132 are defined by, or even adjacent to, inner catheter 72 (Mische; figure 5). Accordingly, applicant respectfully asserts that claim 10 is not anticipated by Mische.

Claim 10 further specifically recites a treatment system comprising “a plurality of circumferentially spaced-apart structures disposed along a majority of the length of the fluid passage *between the wall of the inner member and the wall of the outer member* with the circumferentially space-apart structures spacing the wall of the inner member from the wall of the outer member” (claim 10, lines 10-11). Again, using the examiner's own analogy of the claimed inner member being analogous to inner catheter 72, the claimed outer member being analogous to outer catheter 70, and the claimed plurality of circumferentially spaced-apart structures being analogous to septal areas 134, 136, 138 and 140 of Mische, the examiner has not shown where Mische discloses plurality of circumferentially spaced-apart structures (134, 136, 138, 140) disposed ... *between the wall of the inner member (72) and the wall of the outer member (70)*. The septal areas 134, 136, 138 and 140 are integrally formed and completely defined *within* the wall of outer catheter 70 itself, not *between* the wall of outer catheter 70 and the wall of

inner catheter 72. None of septal areas 134, 136, 138 and 140, are defined by, or even adjacent to, inner catheter 72 (Mische; figure 5). For such additional reasoning, applicant respectfully asserts that claim 10 and its dependent claims are not anticipated by Mische

Claims 20 and 27 include limitations similar to claim 10 (claim 20, lines 8-11; claim 27, lines 6-10). Accordingly, claims 20 and 27, as well as their respective dependent claims, are likewise believed not anticipated by Mische for at least the same reasons as claim 10, as well as for the merits of their own respective limitations.

Claims 20 and 24-29 stand rejected under 35 USC 102(e) as being anticipated by US Patent 6,786,918, Krivoruchko et al., hereafter Krivoruchko. However, claim 20 also stands rejected under 35 USC 103(a) as being unpatentable over *the combination* of Bevier in view of Krivoruchko. With such obviousness rejection the examiner is implicitly admitting that Krivoruchko itself does not anticipate the subject matter of claims 20 and 27 if Krivoruchko must be combined with Bevier to form a *prima facie* case of obviousness. Accordingly, applicant's respectfully assert that claims 20 and 27, as well as their respective dependent claims, cannot be anticipated by Krivoruchko.

Claims 10-19 and 20-23 are rejected under 35 USC §103(a) as being unpatentable over US Patent 6,190,393, Bevier, in view of Krivoruchko. In setting forth the rejection the examiner acknowledges that Bevier does not disclose a spacer structure. Instead, the examiner is relying on Krivoruchko, asserting that Krivoruchko discloses a plurality of circumferentially spaced-apart structures and further asserting that it would have been obvious at the time of the invention to one of ordinary skill in the art to combine the spacer structure into the invention of Bevier.

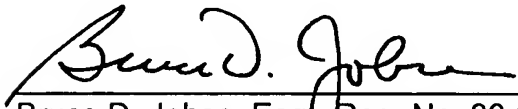
Applicant traverses the rejection of claims 10-19 and 20-23 under 35 U.S.C. §103(a) on the grounds that the Examiner has failed to create a *prima facie* case of obviousness. In accordance with MPEP §2143.03, to establish a *prima facie* case of obviousness 1) the prior art reference (or references when combined) must teach or suggest *all* of the claim limitations; 2) there must be some suggestion or motivation to modify a reference or combine references; and 3) there must be a reasonable expectation of success. The Patent and Trademark Office bears the burden of initially establishing a *prima facie* case of obviousness. MPEP § 2142. "First there must be

some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine what the reference teaches. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all the claim limitations.” The motivation to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not the applicant’s disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). The references must be considered as a whole and must suggest the desirability, and thus the obviousness of making the combination. *Hodosh v. Block Drug Co., Inc.*, 229 U.S.P.Q. 182, 187 n.5 (Fed. Cir. 1986); MPEP § 2141.

The *prima facie* case with respect to these claims fails in two respects. First, the cited references do not teach or suggest all of the claim elements. Secondly, no motivation to combine the two references existed. In setting forth the rejection, the examiner has alleged that the claimed inner member is analogous to balloon catheter shaft 24 of Bevier and that the claimed outer member is analogous to proximal sheath tube 64 of Bevier. The examiner has further alleged that the claimed fluid passage defined between the walls of the inner member and the outer member is analogous to inflation lumen 30 of Bevier. Applicant respectfully disagrees and believes the examiner has misinterpreted Bevier. In Bevier, the inflation lumen 30 is completely defined within balloon catheter shaft 24 and is not defined between the wall of the balloon catheter shaft 24 and the distal sheath tube 64, as recited in claim 10. The examiner has not shown Bevier discloses a “fluid passage defined between the wall of the inner member and the wall of the outer member” (claim 10, lines 10-11). Krivoruchko does not supply the teaching missing from Bevier. As such, the examiner has failed to establish a *prima facie* case of obviousness because the combined cited references do not teach or suggest all of the claim elements. Accordingly, applicant respectfully asserts that claim 10 as well as its respective the pending claims is not obvious in light of the combined teachings of Bevier in view of Krivoruchko. Claim 21 includes limitation language similar to claim 10 and is likewise believed patentable over the combined teachings of Bevier in view of Krivoruchko for at least the same reasons as claim 10.

Applicants believe the claims are in allowable condition. A notice of allowance for this application is solicited earnestly. If the Examiner has any further questions regarding this amendment, she is invited to call Applicant's attorney at the number listed below. The Examiner is hereby authorized to charge any fees or credit any balances under 37 CFR §1.17, and 1.16 to Deposit Account No. 02-3038.

Respectfully submitted,



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